REMARKS

The Examiner has rejected the independent claims of the present application "under 35 U.S.C. § 102(e) as being anticipated by . . . Mitsutake et al." *Office Action*, 3. A number of the dependent claims of the present application have also been rejected per Mitsutake et al. See *Office Action*, 3.

Applicants have amended the independent claims of the present application to recite, generally, a pre-fetch module for identifying a file to be transferred from a source device to a destination device based on, in part, observations of user behavior.

For example, independent claim 1 now recites, *inter alia*, 'identifying a file to be transferred from a source device, wherein a pre-fetch module at a destination device identifies the file to be transferred from the source device based on, in part, observations of user behavior.'

Claim 11 similarly recites:

> a destination device configured to send a request to a source
> device for transfer of a file from the source device to the
> destination device, wherein the file to be transferred from the
> source device to the destination device is identified by a pre-fetch
> module based on, in part, observations of user behavior at the
> destination device.

The method set forth in claim 26 now includes the step of 'identifying a file via a pre-fetch module at a destination device, wherein the identified file is to be transferred to the destination device and identification of the file is based, in part, on observations of user behavior' whereas the system of claim 38 comprises 'a client configured to send to a server a request for delivery of the content, the client comprising a pre-fetch module configured to identify content for delivery based, in part, on observations of user behavior.'

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Claim 57, as amended, now includes 'means for requesting, at a destination device, a transfer of a file from a source device, the means for requesting comprising means for identifying the file to be transferred based on, in part, observations of user behavior.'

Finally claim 58 includes:

'at least one pre-fetch module in the network, the pre-fetch module configured to identify a file to be transferred from at least one of the plurality of servers to at least one of the plurality of clients, the identification of the content based, in part, on observations of user behavior at at least one of the plurality of clients.'

The claimed pre-fetch module, which is configured to identify a file for transfer based on, in part, observations of user behavior is not found in the disclosure of Mitsutake et al. (U.S. patent number 6,240,460). As such, the Applicants contend the Examiner's 35 U.S.C. § 102(e) rejection to have been overcome.

For example, the Examiner—with regard to previously recited claims 7 and 8—asserted Mitsutake to disclose "a pre-fetch module at the destination device [that] identifies the file to be transferred from the source device" and that the pre-fetch module "is configured to identify files to be transferred based on observations of user behavior." *Office Action*, 7-8. The Applicants respectfully disagree and, for at least that reason, believe the amendments to the independent claims (as discussed above) evidence the allowability of the present application over Mitsutake et al.

Pre-Fetch Module

With regard to Mitsutake's purported disclosure of a pre-fetch module (as previously found in, for example, previously cited claim 7), the Examiner identified the 'data transmission identifier' recited in column 16, limes 15-30 and at column 18, lines 29-49. See *Office Action*, 7. As an initial matter, column 16 of Mitsutake, as cited by the Examiner, makes no reference to the aforementioned 'data transmission identifier.' Column 16 discloses a data transmitter, a data receiver, and a transmission medium. See '460:16:15-17. The aforementioned data transmitter, according to Mitsutake, includes "a

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data transmission instruction reception section 5, a data transmission control section 6, and a data transmission section 7." '460:16:19-21. None of these elements of Mitsutake resemble a pre-fetch module as would be understood by one or ordinary skill in the art.

Column 18 of Mitsutake, as cited by the Examiner, fares no better with regard to evidencing the presently claimed pre-fetch module. For example, lines 29-37 pertain to a data transmission start period that indicates the head time and end time of the period in which a data transmission should be started. See '460:18:29-37. While lines 38-40 finally refer to the Examiner's previously referenced 'data transmission identifier,' Mitsutake explains that identifier to "[i]dentif[y] which data transmission the transmission instructions are applied." '460:18-38-40. There is no suggestion as to a module for pre-fetching content as is indicated by the plain and ordinary meaning of the claim language. See *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369 (Fed. Cir. 2004) (requiring claims to be interpreted as broadly *and reasonably* as possible) see also MPEP § 2111.01(I).

Ordinary, simple words whose meaning is clear and unquestionable must be given that plain meaning unless the specification provides otherwise. See *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372 (Fed. Cir. 2004). The Applicants contend no such alternative meaning to have been provided as the specification clearly supports the plain and ordinary meaning of a pre-fetch module, for example, a software module that requests delivery of content without a specific request from the user. See *Specification*, p. 11, l. 1-3. In that regard, Mitsutake fails to disclose a pre-fetch module.

The remainder of column 18 of Mitsutake, as referenced by the Examiner (l. 41-49), further fails to disclose a pre-fetch module. This portion of Mitsutake refers to a data transmission termination (stop) period. See '460:18:41. This period, as explicitly referenced by Mitsutake, "[i]dicates the head time and end time of the period in which the data transmission should be terminated (stopped)." '460:18:42-43. This portion of Mitsutake, like the other portions of Mitsutake referenced by the Examiner, fails to disclose the presently claimed pre-fetch module.

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Identification of Files Based on User Behavior

Mitsutake also fails to disclose the aforementioned pre-fetch module being configured to identify a file for transfer based on, in part, observations of user behavior (as found in, for example, previously cited claim 8). Notwithstanding, the Examiner identifies column 17, lines 24-67 and column 18, lines 1-49 as disclosing this particular configuration. See *Office Action*, 8. Again, the Applicants respectfully traverse.

Column 17, lines 24-30 of Mitustake actually pertain to a document printing application, specifically the ISO 10175, which is a protocol used by major print vendors for ease of printing over the Internet. See '460:17:-24-30.

Lines 31-34 of Mitsutake pertain to data transmission control information, specifically a data transmitter identifier for "indicat[ing] the data transmission station name." '460:17:33-34.

Lines 35-40 of Mitsutake concern a data transmission identifier to "identif[y] which data transmission the data transmission information relates to." '460:17:38-40. Lines 41-42 concerning certification of data transmission information while lines 43-47 concern data transmission routes. See '460:17:41-47.

Lines 48-52, 53-55, and 56-58 of Mitsutake pertain to transmission data amounts, data transmission start periods, and data transmission stop periods, respectively. See '460:17:48-58.

Lines 59-61 of Mitsutake concern a "range of a use bandwidth requested for the data transmission." '460:17:60-61. Lines 62-64 concern a control range of use transmission bandwidth while lines 65-67 concerning priority of data transmissions. See '460:17:62-67.

Lines 1-49 of Mitsutake further fail to disclose a pre-fetch module configured to identify files for transmission based on, in part, user behaviors. This portion of Mitsutake discloses a variety of transmission instructions, none of which related to a pre-fetch module or observed user behavior.

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A careful reading of Mitsutake—as detailed above—shows that a pre-fetch module configured to pre-fetch content based on, in part, user behavior is not disclosed by Mitsutake.

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CONCLUSION

The Applicants contend the art of record fails to teach each and every claimed limitation of the present application, at least with regard to a pre-fetch module configured to identify files based on, in part, observed user behavior. As a similar limitation is found in each and every one of the independent claims of the present application, the Applicants contend the Examiner's rejection of the aforementioned independent claims is overcome. As each of the dependent claims incorporates by reference one of the aforementioned independent claims as required by 35 U.S.C. § 112, ¶ 4, the Applicants contend each and every one of the dependent claims to also be allowable. As such, the Applicants contend the present application to be in condition for allowance and request the issuance of a notice of allowance recognizing the same.

The Applicants note that while the claims of the application have been amended, a final rejection should not be necessitated by these amendments. See MPEP § 706.07(a) (finding a final rejection to be *improper* when a new rejection is rendered, that rejection *not* being necessitated by a prior amendment). The amendments made to each of the independent claims include certain limitations previously identified, for example, in previously pending claims 7 and 8. As such, these limitations have been previously examined and a rejection rendered on the same. That rejection, as noted above, failed to evidence the anticipation of these claim elements. Overcoming this rejection therefore evidences the allowability of the present application.

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The Examiner is invited to contact the Applicants' undersigned representative with any questions concerning the present application or amendment.

Respectfully submitted,
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March 27, 2006   By: *Kenneth M. Kaslow*

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